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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204404
Party	Defendant Vincent Motors LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DAVID M. HOLDER,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91204404
)	Cancellation No. 92055541
VINCENT MOTORS LLC/)	
EICHER MOTORS LTD.)	
)	
Applicant.)	

**APPLICANT VINCENT MOTORS LLC’S (AND EICHER MOTORS LTD.’S)¹
MOTION FOR RECONSIDERATION
OF THE BOARD’S DECEMBER 17, 2014, ORDER**

On December 17, 2014,² the Trademark Trial and Appeal Board issued a decision in the above-captioned proceeding (1) granting in part and denying in part Applicant Vincent’s Motion to Strike Opposer David M. Holder’s Reply to Applicant’s Opposition to Holder’s Motion for Summary Judgment, and (2) granting in part and denying in part Opposer Holder’s Motion for Summary Judgment.³ Vincent respectfully requests that the Board reconsider those decisions

¹ As noted in Applicant’s past filings in this proceeding, Vincent Motors LLC assigned to Eicher Motors Ltd. all rights, title, and interest in and to the marks that are the subject of the instant proceeding. For ease of reference, this motion refers to Vincent Motors LLC and Eicher Motors Ltd. collectively as “Vincent,” consistent with the Board’s nomenclature in its December 17, 2014, Order.

² Pursuant to 37 C.F.R. § 2.127(b), this motion is filed within one month from the date of the Order, which was January 17, 2015. That date was a Saturday, so it is due the next business day, January 20, 2015. Fed. R. Civ. P. 6; 37 C.F.R. § 2.196.

³ See Order, Dec. 17, 2014, ECF No. 44. The Board also denied Applicant’s Motion to Substitute Party. See *id.* That portion of the decision is not at issue in this motion.

because it believes the Board made a mistake: When the Board decided not to strike the Healy declaration—which Holder attached to his Reply brief and which included new information improperly withheld from Vincent during discovery—it grounded its decision in its conclusion that Vincent failed to ask Holder during his deposition about the alleged license with Healy’s company, Coventry Spares, including when the license commenced. The Board was mistaken. As the deposition transcript excerpts submitted with Vincent’s Opposition show, Vincent *did ask* Holder the commencement date of the alleged license, and also asked for other information about the alleged license, but Holder refused to provide meaningful answers.⁴ As a result, the Board should have stricken the Healy declaration. And because the Board substantially relied upon the Healy declaration as grounds for partially granting summary judgment, the Board should also reconsider that decision. Indeed, in the absence of the Healy declaration, Holder’s evidence does not satisfy his burden of demonstrating there is no genuine issue of material fact that Holder established use in the United States and priority with respect to any of the marks. Vincent does not wish to rehash legal arguments already decided by the Board. Rather, Vincent seeks reconsideration because of the Board’s mistake regarding what was requested and what was provided in discovery regarding Coventry Spares, what was asked at Holder’s deposition on that topic, and the subsequent impact on the Board’s summary judgment decision.⁵

⁴ See Applicant’s Opp’n to Opposer’s Mot. for Summ. J., Ex. 1., at 67:2-78:6, July 28, 2014, ECF No. 38.

⁵ See 37 C.F.R. § 2.127(b) (“Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof.”); Fed. R. Civ. P. 60(a) (“The court may correct . . . a mistake arising from oversight or omission whenever one is found in a judgment, order, or other part of the record.”); Fed. R. Civ. P. 60(b)(1) (“[T]he court may relieve a party . . . from a[n] . . . order . . . for . . . mistake”); *see also, e.g., Steiger Tractor, Inc. v. Steiner Corp.*, Opposition No. 65603, 3 U.S.P.Q. 2d 1708, 1710, 1984 WL 62978

THE PARTIES' SUMMARY JUDGMENT BRIEFING AND THE BOARD'S DECISION

On June 27, 2014, Holder filed a Motion for Summary Judgment on Holder's petition for cancellation of Vincent's registrations of the marks VINCENT⁶ and VINCENT HRD⁷ for use in connection with caps, jackets, shirts, and t-shirts (Class 25); and on Holder's opposition to Vincent's registration of the mark VINCENT⁸ for use in connection with motorcycles and structural parts therefor (Class 12) and motorcycle helmets (Class 9).⁹ Holder argued that he and his predecessors-in-interest used the marks in the United States prior to Vincent, and that he was therefore entitled to common law rights to the marks. Holder further argued that, even if he did not use the marks prior to Vincent, his foreign-registered marks are "famous" and "well-known" and therefore entitle him to rights in the United States notwithstanding a lack of prior use.

Vincent filed an Opposition on July 28, 2014, arguing that genuine issues of material fact exist as to whether Holder actually used the marks in the United States on a continuous basis prior to Vincent's date of priority.¹⁰ Vincent emphasized that Holder must conclusively establish his use of the marks prior to Vincent's earliest use, which was in 1994, or at least prior to 2003 (when Vincent's registrations claim use) for use in connection with caps, jackets, shirts, and t-shirts, and prior to August of 2011 (the date of Vincent's intent-to-use application) for

(TTAB 1984) (reconsidering decision to dismiss opposition and instead deciding to sustain opposition "on further reflection").

⁶ U.S. Reg. No. 4128589, issued Apr. 17, 2012.

⁷ U.S. Reg. No. 4128588, issued Apr. 17, 2012.

⁸ App. Serial No. 85397317, filed Aug. 13, 2011 (published for opposition Jan. 31, 2012).

⁹ See Opposer's Mot. for Summ. J., June 27, 2014, ECF No. 31.

¹⁰ See Applicant's Opp'n to Opposer's Mot. for Summ. J.

motorcycles and structural parts therefor and helmets. But Vincent pointed out at length in its Opposition that Holder cited no evidence—apart from inconsistent statements during his deposition and in his declaration—that Holder or his company Velocette used the marks in the United States before even 2003. Instead, Holder cited to a hodgepodge of images and advertisements that either had no apparent connection to Holder or postdated the commencement of this proceeding and therefore failed to evince use and priority.

Holder filed a Reply to Vincent’s Opposition on August 12, 2014—attaching two new declarations from Holder’s alleged oral licensees, John Healy and Patrick Godet, along with nine new exhibits.¹¹ Vincent, having already filed its Opposition, and thus having no opportunity to respond to the new evidence, and having unsuccessfully requested from Holder during discovery the very information contained in the new declarations, filed a Motion to Strike the new declarations and exhibits pursuant to TBMP §§ 527.01(e) and 528.05(b).¹²

On December 17, 2014, the Board ruled on Vincent’s Motion to Strike and Holder’s Motion for Summary Judgment.¹³ The Board first decided Vincent’s Motion to Strike, granting Vincent’s request to strike the Godet declaration, but denying Vincent’s request to strike the Healy declaration. In reaching its decision, the Board ruled that neither declaration was untimely, despite being attached to Holder’s Reply, because the declarations “corroborate and elaborate on Holder’s discussion in his motion” regarding alleged sales through U.S. distributors and “are responsive to Vincent’s argument that Holder has submitted no corroborating evidence

¹¹ See Opposer’s Reply Br., Aug. 12, 2014, ECF No. 40.

¹² See Applicant’s Mot. to Strike Opposer’s Reply Br., Aug. 21, 2014, ECF No. 41.

¹³ See Order at 5-20.

regarding distributors for his parts and clothing or his alleged licensing agreements with them.”¹⁴ Thus, the Board concluded that the declarations constituted “proper rebuttal.”¹⁵ But because “Holder failed to disclose Godet or his company” in response to Vincent’s interrogatory, the Board ruled that the Godet declaration should be stricken and excluded from consideration. Finally, the Board ruled that the Healy declaration should *not* be stricken and excluded from consideration because: “Holder identified Coventry Spares as his main licensee” in response to Vincent’s interrogatory; Holder discussed his licensing agreement with Coventry Spares in his deposition; and “there is no evidence that Vincent asked any questions regarding the nature of the arrangement with Coventry Spares, nor is there any evidence that Vincent inquired as to when the licensing arrangement had commenced.”¹⁶

Having decided that the Healy declaration would not be stricken, the Board then granted in part and denied in part Holder’s Motion for Summary Judgment.¹⁷ The Board granted Holder’s motion with respect to Holder’s petition to cancel Vincent’s registrations for marks VINCENT and VINCENT HRD; sustained Holder’s opposition to Vincent’s application for the mark VINCENT for uses in connection with motorcycles and structural parts therefor (Class 12); and denied Holder’s opposition to Vincent’s application for the mark VINCENT for uses in connection with motorcycle helmets (Class 9). The Board found that Holder met his burden of establishing use and priority of use in connection with motorcycle parts, accessories, and

¹⁴ *Id.* at 6.

¹⁵ *Id.*

¹⁶ *Id.* at 7.

¹⁷ *Id.* at 8-20.

clothing, such that there was no genuine issue of material fact. In reaching its decision, the Board relied on two declarations. First, the Board cited the Holder declaration, where Holder attested that he has manufactured and sold clothing bearing the VINCENT and VINCENT HRD marks since before 1990, and which included as exhibits photographs of motorcycle parts and clothing bearing the marks.¹⁸ Second, the Board cited the Healy declaration—which Vincent had moved to strike—where Healy attested that his company, Coventry Spares, has orally licensed the marks from Holder, or Holder’s father, in connection with the sale of motorcycle parts, accessories, clothing, and parts lists from 1978 to August of 2014, and which corroborated that the photographs were products sold in the United States—something Holder did not show.¹⁹ Based on the Holder and Healy declarations, the Board concluded that “Holder, through his licensee Coventry Spares, has used the marks VINCENT and VINCENT HRD in the United States in connection with motorcycle parts and accessories and clothing, namely, caps and t-shirts, since at least as early as 1978.”²⁰

ARGUMENT

I. Because the Healy Declaration Is Inadmissible, the Board Should Have Excluded It From Consideration When Deciding the Motion for Summary Judgment.

The Board erred when it decided not to strike the Healy declaration and to instead consider the declaration when deciding Holder’s Motion for Summary Judgment. First, the Board should have stricken the Healy declaration on the grounds that Holder used the declaration to introduce information about an alleged oral license with Coventry Spares that Holder had

¹⁸ *Id.* at 11.

¹⁹ *Id.* at 11-12.

²⁰ *Id.*

improperly withheld from Vincent during discovery.²¹ The Board inadvertently overlooked portions of Holder’s deposition testimony when it decided Holder did not withhold information about the alleged Coventry Spares license he submitted through the Healy declaration. And second, the Board should have stricken the Healy declaration on the grounds that Holder improperly used his Reply brief to introduce new testimonial evidence and arguments to which Vincent had no opportunity to respond.²²

A. The Board Should Have Stricken the Healy Declaration Because Holder Improperly Withheld Information About the Alleged Coventry Spares License from Vincent During Discovery.

Even if the Healy declaration was timely, the Board made a mistake by considering the evidence on summary judgment because Holder improperly withheld information about the alleged Coventry Spares license from Vincent during discovery. The Board concluded that Holder did *not* improperly withhold such information from Vincent, and instead identified Coventry Spares as Holder’s “main licensee” in response to Vincent’s interrogatories and discussed the licensing arrangement at his deposition.²³ The Board further concluded that “there is no evidence that Vincent asked any questions regarding the nature of the arrangement with Coventry Spares, nor is there any evidence that Vincent inquired as to when the licensing arrangement had commenced.”²⁴ But the Board’s factual conclusions warrant further review because the Board mistakenly overlooked certain key evidence Vincent submitted with its Opposition.

²¹ See Mot. to Strike at 3-4.

²² *Id.* at 1-2.

²³ Order at 7.

²⁴ *Id.*

Although it is true that Holder identified Coventry Spares as his “main licensee” in response to Vincent’s interrogatories, he declined to provide additional information about the license that Vincent requested in the interrogatory. Vincent asked Holder to “[i]dentify and describe the *facts concerning any agreements* between” Holder and potential licensees.²⁵ By responding merely that Coventry Spares was a “main licensee,” Holder withheld “facts concerning” the license, including the basic terms of the license. After withholding the information from his interrogatory response, thereby denying Vincent the ability to meaningfully probe the license during discovery, Holder then submitted the basic facts and terms of the alleged license through the Healy declaration to support his Motion for Summary Judgment.²⁶

Even during Holder’s deposition, despite Vincent’s efforts to extract information from Holder about the alleged oral license with Coventry Spares, Holder refused to provide clear information and obfuscated in response to nearly every question about Coventry Spares. For instance, although the Board concluded, “nor is there any evidence that Vincent inquired as to when the licensing arrangement had commenced,”²⁷ Vincent’s counsel actually did ask Holder this question, directly, during Holder’s deposition: “And how long have they [Coventry Spares] been a licensee of yours?” Holder responded in characteristically vague fashion, “Right back to me dad’s day.”²⁸ Vincent’s counsel attempted to obtain additional information from Holder about his alleged oral license with Coventry Spares, including the terms of the alleged license to

²⁵ See Applicant’s Mot. to Strike at 3-4 & Ex. A.

²⁶ See Opposer’s Reply Br., Declaration of John Healy, ¶ 2.

²⁷ Order at 7.

²⁸ See Applicant’s Opp’n, Ex. 1, at 67:19-21.

use the marks in connection with clothing, but Holder continued to provide vague responses and avoided disclosing (or committing to) the terms of the license.²⁹ After withholding the information from Vincent during his deposition, Holder then submitted the information in support of his Motion for Summary Judgment via the Healy declaration.³⁰

Because Holder's failure to disclose information about the alleged Coventry Spares license contained in the Healy declaration was not "substantially justified or . . . harmless," the evidence in the Healy declaration is inadmissible, and the Board should not have considered it in deciding Holder's Motion for Summary Judgment.³¹ The Board suggested that Holder's interrogatory answer identifying Coventry Spares was sufficient, and that Vincent should have inquired about the terms of the alleged license during Holder's deposition. But a close reading of the Holder deposition excerpts submitted with Vincent's Opposition reveals precisely this. Holder, like in his interrogatory responses, refused to meaningfully answer the questions or reveal details of the license.³² To the extent Holder was unable to answer basic questions about the alleged license, Vincent asserts that there is insufficient evidence that there ever was a license or sales via a license in the United States.

B. The Board Should Have Stricken the Healy Declaration Because Holder Improperly Used His Reply Brief to Introduce the New Evidence, Denying Vincent an Opportunity to Respond.

In ruling that the Healy declaration was not untimely, and not "improper rebuttal," the Board explained that the declaration corroborated and elaborated upon Holder's use and priority

²⁹ See generally *id.* at 67:2-78:6.

³⁰ See Opposer's Reply Br., Declaration of John Healy, ¶ 2.

³¹ See TBMP §§ 527.01(e), 528.05(b).

³² See Applicant's Opp'n, Ex. 1., at 67:2-78:6.

discussion in his motion.³³ The Board explained, “The materials accompanying Holder’s reply also are responsive to Vincent’s argument that Holder has submitted no corroborating evidence regarding distributors for his parts and clothing or his alleged licensing agreements with them.”³⁴ But these justifications miss the point. If Holder had responded with arguments alone, or even by citing additional evidence properly produced to Vincent during discovery, Vincent would not have objected because it would have had a fair opportunity to preempt the arguments or counter the existing evidence in its Opposition. But Holder’s Reply instead introduced *new evidence* from a *new declarant* to rebut Vincent’s Opposition with information not introduced during discovery. Vincent had no way of anticipating, let alone preempting or countering, the new arguments because Holder withheld the information and evidence during discovery.

For the Board to permit Holder to gin up new evidence through eleventh-hour declarations to respond to Vincent’s key arguments regarding Holder’s lack of use, without Vincent having an opportunity to even respond to the new evidence, tilts the balance of fairness in favor of Holder—who happens to be the movant and carries the burden of proof. The Board effectively shifted the original burden of proof to Vincent. The impact of permitting such evidence—insulated from Vincent’s analysis and attack—is clear. Indeed, in its decision, the Board substantially relied on the Healy declaration to conclude Holder demonstrated use and thus priority.³⁵ And yet the Board’s substantial reliance on the Healy declaration belies the notion that the Healy declaration merely “corroborate[d],” “elaborate[d],” or was “responsive” to

³³ See Order at 6.

³⁴ *Id.*

³⁵ See *id.* at 11-12.

Vincent's arguments. To the contrary, the Healy declaration appears to have been the only evidence of use in the United States cited by the Board.

II. The Board Erred When It Partially Granted Summary Judgment Because It Substantially Relied Upon the Healy Declaration, Which Is Inadmissible, and the Remaining Evidence Raises a Genuine Issue of Material Fact as to Holder's Continuous Use in the United States.

The Board partially granted Holder's Motion for Summary Judgment largely because of the Healy declaration, which the Board relied upon in finding that Holder used the marks prior to Vincent. The Board explained:

Holder submitted the declaration of John Healy, the owner and chief manager of Coventry Spares, who attests that Coventry Spares operates under an oral license from Holder by which it sells motorcycle parts and accessories, clothing, and parts lists and other literature such as instruction manuals, under the trademarks VINCENT and VINCENT HRD; that it has operated under that license since approximately 1978; that his company has sold those products in the United States under those trademarks essentially continually from 1978 to August 7, 2014, the date of his declaration; and that the license was originally granted by Holder's father and was continued with Holder when he took over the business in the 1980s. . . . The foregoing evidence shows that Holder, through his licensee Coventry Spares, has used the marks VINCENT and VINCENT HRD in the United States in connection with motorcycle parts and accessories and clothing, namely, caps and t-shirts, since at least as early as 1978.³⁶

But the Board's reliance on the Healy declaration was a mistake. As discussed above, the Board should not have considered the declaration in reaching the question of priority.³⁷ And in the absence of the Healy declaration, Holder's remaining evidence raises genuine issues of material fact regarding priority.

³⁶ See Order at 11-12.

³⁷ See *supra* Part I.A.

Aside from the Healy declaration, the only other evidence the Board relied upon in finding Holder proved priority is Holder's personal declaration. The Board explained, "Holder, in his declaration, attests that he, through Velocette Vincent, manufactures and has sold motorcycle parts and accessories and clothing in the United States since long prior to 1990 under the marks VINCENT and VINCENT HRD."³⁸ But as set forth more fully in Vincent's Opposition, which responds to all evidence submitted by Holder before the August, 2014, creation of the Healy declaration, Holder cites no convincing evidence to support his conclusory assertions of use prior to 2011 or 2003, let alone 1994.³⁹ As explained at length in Vincent's Opposition, viewing Holder's remaining evidence of use in a light most favorable to non-movant Vincent, and drawing all reasonable inferences in Vincent's favor,⁴⁰ the Board should have ruled that Holder failed to establish that there are no genuine issues of material fact in dispute with respect to Holder's alleged use in the United States and priority.

³⁸ Order at 11.

³⁹ See Opp'n Ex. 1, at 41, 45-51.

⁴⁰ See *id.* at 7-8 (discussing summary judgment standard).

CONCLUSION

For the foregoing reasons, Applicant requests that the Board reconsider and vacate its Order of December 17, 2014, and enter an order striking the Healy declaration and denying Opposer's Motion for Summary Judgment in its entirety.

Date: January 20, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is hereby certified that the foregoing Motion for Reconsideration of the Board's December 17, 2014, Order was served upon the following attorney of record for Opposer by email (as agreed by the parties), this 20th day of January, 2015:

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